



Serial No.: 09/777,492
Docket No.: 773919-0511

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s) : Stephen B. Bove, et al.
Serial No. : 09/777,492
Filing Date : February 5, 2001
Title : System and Method for Anonymous Lead Generation
and Management
Group/Art Unit : 3692
Examiner : Siegfried E. Chencinski
Confirmation No. : 8359
Docket No. : 773919-0511

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the Examiner's rejections of claims 1-25 of the above-identified application made in the Office Action of June 18, 2007. No amendments are being filed with this request. This request is being filed concurrently with a three month Petition for Extension of Time, along with a check for \$1050 to cover the time extension fee. This request is also being filed concurrently with a Notice of Appeal, applying \$500 in previously paid appeal fees submitted with the Notice of Appeal previously filed on July 13, 2006 in the present application. A check for \$10 is enclosed to cover the subsequent increase in the filing fee for a Notice of Appeal. If any additional fees are required, the Director is authorized to charge Applicant's Deposit Account as indicated below. Review of the claim rejections is requested for the reasons stated below:

1. The Examiner clearly erred in rejecting claim 21 under 35 U.S.C. § 101 as not directed to statutory subject matter. The Examiner stated that claim 21 was not statutory subject

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matter because the invention in claim 21 is software. Part I of M.P.E.P. § 2106.01 states that if a "computer program is being claimed as part of an otherwise statutory manufacture or machine [then] the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program."

Claim 21 is directed toward "A computer-implemented method for anonymously connecting sales agents with consumers of housing, comprising: (a) providing a software application . . .". Claim 21 is directed to statutory subject matter, in accordance with M.P.E.P. § 2106.01, because claim 21 claims a computer program that is used in a computerized process where a computer executes the instructions set forth in the computer program. Therefore, the Examiner clearly erred in rejecting claim 21 under 35 U.S.C. § 101.

2. The Examiner clearly erred in rejecting claims 1 and 9 under the written description requirement of 35 U.S.C. § 112, ¶ 1. In rejecting the claims the Examiner stated that "[t]he claimed anonymity does not exist in Applicant's disclosure even though the language of anonymity is used". Office Action of June 18, 2007, p. 2. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention at the time the application was filed. M.P.E.P. § 2163, Part I.

As originally filed, the specification of the application states:

One object of this invention is to enable generation of business leads, which are completely anonymous. These business leads are anonymous in at least two respects: (1) they are anonymous in that a business expert reviewing the lead can neither identify nor contact the consumer independently from the lead generation system; and (2) they are anonymous in that even the provider of the lead generation system is generally unable to identify the consumer because the system is able to function using only a small set of device identifiers, which include both permanent and session identifiers.

Applicant's application at ¶ [14], pp.3-4.

The specification of the present application describes a system and method for generating

anonymous leads from anonymously submitted database search criteria. Referring to Fig. 1 of the present application, and the accompanying description, either a registered or an unregistered consumer uses a search-requestor device 140 to submit search criteria to server 120. ¶¶ [32] & [34], p.7. For each type of consumer, registered or unregistered, the user database 126 stores a user identifier and the search criteria. ¶ [34], p.7. For an unregistered consumer, the user identifier is equivalent to a device identifier. ¶ [36]-[37], p.8. The consumer's stored search criteria is organized as a prospect which may be presented as a lead to a business expert. ¶ [11], p.3. For an unregistered consumer, the business expert may send a proposal to server 120 for the consumer. *Id.* If the search-requestor device 140 connects to the server 120 again, then the server will forward the proposal to the device for viewing by any person, including the unregistered consumer. ¶¶ [37-39], pp.8-9. Thus, the business expert may only communicate with the search-requestor device through the server and the server may only communicate with the unregistered consumer through the search-requestor device. The actual unregistered consumer that originally used the particular search-requestor device is "truly" anonymous in that neither the business expert nor the server has any information about that person's identity. There is no way that a business expert can identify the unregistered consumer that submitted the search criteria to the server.

The Examiner states the specification does not disclose anonymity because the "Applicant makes use of the electronic and software identifier features of the internet". Office Action at p.3. Even though an electronic identifier is used to identify a search-requestor device used by an unregistered consumer, no information about the unregistered consumer is ever submitted. The Examiner's arguments indicate that the Examiner confuses anonymity of the consumer with anonymity of a particular search-requestor device. While the server 120 stores search-requestor device information, the server does not store consumer identifying information. Further, there is no link between a search-requestor device and an unregistered consumer which could identify the consumer. Therefore, the Examiner clearly erred in rejecting claims 1 and 9 under the written description requirement of 35 U.S.C. § 112, ¶ 1.

3. The Examiner clearly erred in rejecting claims 1 and 9 under 35 U.S.C. § 112, ¶ 2 as being incomplete for omitting essential steps. The Examiner states that claim 1 is missing an essential step between step (b) and step (c). Step (b) requires "transmitting said prospect information to a business expert in a prospect presentation, wherein the prospect presentation is designed to enable generation of a proposal . . ." and step (c) requires "transmitting said proposal to a device . . .". The Examiner, in citing M.P.E.P. § 2172.01, asserts that the essential missing step is "generating a proposal to be transmitted OR the declining by the business expert of doing so, and the termination of the steps at that point." Office Action, page 3.

M.P.E.P. § 2172.01 presents two rejection scenarios. First, a claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under the enablement requirement of 35 U.S.C. 112, ¶ 1. Second, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, ¶ 2, for failure to point out and distinctly claim the invention.

Neither the first scenario nor the second scenario are applicable here because there are no statements, in the specification or otherwise, that "generating a proposal" is essential to the invention. Therefore, the claim does interrelate all the essential elements of the invention. Further, claims 1 and 9 are definite and clear when read in light of Figs. 4 and 5 and ¶¶ [92]-[112] of the present application which describe how a proposal is generated by a business expert. Therefore, the Examiner clearly erred in rejecting claims 1 and 9 under 35 U.S.C. § 112, ¶ 2 as being incomplete for omitting essential steps.

4.(a) The Examiner clearly erred in rejecting claims 1, 9 and 16 under 35 U.S.C. § 112, ¶ 2 for lack of antecedent basis for "transmitting said proposal" in step (c) of claim 1. The Examiner states that there is insufficient antecedent basis for this limitation because there is no prior step which creates the proposal. The antecedent basis for "transmitting said proposal" is in step (b) which requires "wherein the prospect presentation is designed to enable generation of a **proposal**." As described above in Part 3, claims 1 and 9 are definite and clear when read in light

of the specification, which describes how a proposal is generated by a business expert. Claim 16 requires computer program instructions which are similar to claim 1, thus, it is also clear and definite. Therefore, the Examiner clearly erred in rejecting claims 1, 9 and 16 under 35 U.S.C. § 112, ¶ 2.

4.(b) The Examiner clearly erred in rejecting claims 1, 9 and 16 under 35 U.S.C. § 112, ¶ 2 for lack of antecedent basis for the claimed "anonymous leads from anonymously submitted database search criteria" in the preamble and for the "anonymously submitted database search criteria" in claim limitation (a)(ii). There need not be antecedent basis for this clause in the preamble because that is where it appears for the first time in the claim. The argument accompanying the Examiner's rejection seems to be oriented toward 35 U.S.C. § 112, ¶ 1. As discussed in Part 2 of this request, the specification does disclose anonymity and thus, the Examiner's rejection of claims 1, 9 and 16 under 35 U.S.C. § 112, ¶ 2 is clearly erroneous.

5. For the reasons presented in Applicant's Pre-Appeal Brief Requests For Review filed on February 5, 2007 and July 13, 2006, and summarized herein, the Examiner clearly erred in rejecting independent claims 1, 9 and 16 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,574,608 to *Dahod et al.* in view of U.S. Patent No. 6,868,389 to *Wilkins et al.* Neither *Dahod* nor *Wilkins* discloses anonymously submitted search criteria. Instead, *Dahod* teaches away from claims 1, 9 and 16 by disclosing a **registered** buyer submitting information about a product or service that the buyer wishes to purchase. *Dahod* also does not disclose a database which stores device identifying information. The system of *Dahod* does not need to store device identifying information because each buyer is registered. Claims 2-8, 10-15, and 17-20, which are dependent from independent claims 1, 9 and 16, are allowable as dependent from allowable claims.

6. For the reasons presented in Applicant's Pre-Appeal Brief Requests For Review filed on February 5, 2007 and July 13, 2006, and summarized herein, the Examiner clearly erred in rejecting independent claim 21 under 35 U.S.C. § 103(a) as obvious over *Dahod* in view of U.S. Published Application No. 2002/0169626 to *Walker*. As discussed above in Part 5, *Dahod*

does not disclose, as required by claim 21, storing search criteria without a requirement of user registration. *Walker* also requires merchants to register. Therefore, both *Dahod* and *Walker* teach away from claim 21. Claims 22-25 which are dependent from independent claim 21 are allowable as dependent from an allowable claim.

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In view of the foregoing remarks, it is respectfully submitted that the claims of the present application are in condition for allowance and eventual issuance. Such action is respectfully requested.

Should this Review Board have any further questions or comments that need be addressed in order to obtain allowance, it is invited to contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

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